

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

BALL

Serial No.: 10/674,862

Filed: September 30, 2003

Atty. File No.: 5564-153

For: "Overflow Assembly For  
Bathtubs and the Like"

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

) Group Art Unit: 3751

)  
) Examiner: Robert M. Fetsuga

)  
) Confirmation No.: 6280

)  
) REASONS IN SUPPORT OF PRE-  
APPEAL BRIEF REQUEST FOR REVIEW

)  
) Certificate of E-Filing

I Hereby Certify That this Correspondence Is Being E-  
Filed with the United States Patent and Trademark Office  
on 9-28-07

BY: SHERIDAN ROSS P.C.

*Ginger Bovenkamp*

Dear Sir:

Applicant submits this paper in conjunction with the Pre-Appeal Brief Request for Review. It is respectfully submitted that the rejections to pending Claims 12 and 15-39 of the above-identified application are clearly not proper and are without basis and therefore should be withdrawn.

Claim 26 has been rejected under 35 U.S.C. § 112 as being indistinct. Claims 12, 15-31 and 33-39 have been rejected in light of U.S. Patent No. 6,618,875 to Oropallo et al. ("Oropallo"), alone or in combination with U.S. Patent Publication No. 2002/0032926 to Lewis ("Lewis") and U.S. Patent No. 6,192,531 to Fritz et al. ("Fritz"). Claims 20-22 and 33-36 have been rejected as being anticipated over U.S. Patent No. 5,350,266 to Espey et al. ('Espey'). Claims 12, 15-30 and 32-39 have been rejected in view of Swiss Patent No. CH0346187 to Gebert ("Gebert"), alone or in combination with Lewis and Fritz.

These rejections were addressed in an Amendment and Response After Final dated August 1, 2007 (hereinafter "the Amendment"). The Examiner addressed the Amendment in an Advisory Action dated August 8, 2007. The rejected claims and the ongoing behavior of Examiner Fetsuga will be addressed in turn below.

### **Rejections based on Oropallo**

- Claims 20-23 and 33-37 - Oropallo 35 U.S.C. §102(e)
- Claims 23-25 and 37-39 - Oropallo and Fritz 35 U.S.C. §103(a)
- Claims 12, 15-18 and 26-31 - Oropallo and Lewis 35 U.S.C. §103(a)
- Claims 18, 19, 31 and 32 - Oropallo, Lewis and Fritz 35 U.S.C. §103(a)

The above-identified claims have been rejected in view of Oropallo, alone, or in combination with Lewis and Fritz. It is Applicant's contention that Oropallo is not prior art and therefore cannot support a novelty-based rejection, nor can it be combined with Lewis and/or Fritz to support an obviousness rejection under §103. More specifically, as asserted in the Amendment at page 8, line 9, Applicant contends that the previously filed Affidavit pursuant to 37 C.F.R. §1.131 shows a date of conception of the claimed invention prior to the filing date of Oropallo, together with requisite diligence. The Examiner tersely states in his Advisory Action that application serial number 09/593,724, which was relied upon to show one example of diligence from the date of conception to filing, differs from the instant application and thus can not be used as a basis for such diligence. The Examiner's position, however is contrary to governing law. "The facts to be established under 37 CFR §1.131 are similar to those to be proved in interference." MPEP §715.07. The diligence of 35 U.S.C. §102(g) relates to reasonable engineering-diligence, which does not require that an inventor drop all other work and concentrate on the particular invention involved. Emery v. Ronden, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974). Furthermore, diligence can be found based on research activities. In re Jolley, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002). It is well established that "under some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue." Ginos v. Nedelec, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983).

As outlined in the Amendment, Applicant respectfully submits that a date of conception prior to Oropallo, and diligence from that date of conception to the filing of the instant application, has been shown and therefore seeks withdrawal of all rejections based on Oropallo.

### **Rejections based on Espey**

- Claims 20-22, 26-30 and 33-36 - Espey 35 U.S.C. §102(b)

The above-identified claims have been rejected as being anticipated by Espey. Attention is directed to the arguments set forth in the Appeal Brief filed on November 18, 2005 in conjunction with the above-identified application. As succinctly stated therein, there is no teaching that the "lugs" 21-26 of Espey, "frictionally detachably engage" the inner surface of a cap. Rather, Espey's cap is fitted to the nut by pressing downwardly such that the projections 52 snap into slots 33. Such an interconnection is not frictionally detachable because abutting members perform the function of retaining the cap. Since each and every element set forth in the rejected claims are not found in Espey, this rejection must be withdrawn. These statements should be persuasive since upon review of the file history it is apparent that after such statements were made with respect to Espey in the Appeal Brief the application was previously allowed. Since Espey has not changed, the USPTO's indication of allowability of the present invention over Espey should not change.

### **Rejections based on Gebert**

- Claims 20-22 and 33-36 - Gebert 35 U.S.C. §102(b)
- Claims 23-25 and 37-39 - Gebert and Fritz 35 U.S.C. §103(a)
- Claims 12, 15-17 and 26-30 - Gebert and Lewis 35 U.S.C. §103(a)
- Claims 18, 19, 31 and 32 - Gebert, Lewis and Fritz 35 U.S.C. §103(a)

The above-identified claims have been rejected in view of Gebert, alone, or in combination with Lewis and/or Fritz. Applicant respectfully requests that these rejections be withdrawn because the Examiner has misconstrued Gebert.

For example, in a Final Office Action dated May 1, 2007 the Examiner stated that Gebert (a Swiss language reference) discloses "an overflow conduit/pipe 1 including a flange 5 and threads 4; a fastening member/nut 8 including a lug 11 and threads (engaging 4); and a cap 14 including a flange (at 16) and a notch 15, as claimed." Applicant respectfully submits that the Examiner has misconstrued Gerbert, specifically with respect to the lug 11 element. Using publically available translation tools, one skilled in the art would understand Gebert as disclosing a metallic retaining ring 10 positioned between the wall 7 and nut 8. See Lines 30-37 of Gebert. The retaining ring 10

includes an edge that engages a blunt conical retaining face 11 of the cap 14. Id. A lug 13 is firmly attached on the retaining ring. Id. One skilled in the art will appreciate that a lug 11 that extends through the slot 15 of the cap 14 is pulled to deflect the flexible retaining ring 10 to allow the cap 14 to be removed. The retaining ring 10 is conical with a sloped edge that engages a retaining face 11 of the cap 14. In contrast to the claimed invention, the retaining ring 10 of Gebert does not include at least one lug that frictionally engages a cap. Furthermore, the nut 8 of Gebert does not include any of the claimed lugs that frictionally engage a cap. Since Gebert does not include all the elements of Claims 20-22 and 33-36 withdrawal of the rejection based on 35 U.S.C. §102 is proper. In order to support a *prima facie* obvious, a combination of cited references must disclose all of the claimed elements. Since Gebert does not include the features described above, it cannot be used in combination with Lewis and/or Fritz. Thus, it is respectfully asserted that the rejection to Claims 12, 15-19, 23-32 and 37-39 under 35 U.S.C. §103 is improper as well.

#### **Rejections based on Indefiniteness**

Claim 26 has been rejected as being indefinite under §112. Applicant's arguments related to this point can be found in the Amendment at page 7. In light of well-settled precedent, it is respectfully submitted that there can be no confusion as to whether the bathtub is part of the pending claims.

#### **Examiner Fetsuga**

Applicant directs the Pre-Appeal members to arguments already of record in the Petition to Withdraw Holding of Abandonment recently filed in pending application serial number 10/247,247, entitled "Cap for sealing a bathtub overflow port for testing purposes". In such petition, Applicant requests that Examiner Fetsuga be removed as the examiner of a related application. Applicant requests that the statements regarding Examiner Fetsuga be considered in light of the instant application as well.

### **Conclusion**

Based upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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